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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

NO. 176

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED, Petitioners,

v.

THE BENDIX CORPORATION, Respondent.

REPLY BRIEF FOR PETITIONERS

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July 22, 1964.

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(1) Contrary to respondent's assertion, the questions presented by the Petition *are* raised by the record; the quotation (Respdt's. Br. p. 5) from petitioners' brief in the Court of Appeals sufficiently shows this. And respondent's own argument (Respdt's. Br. 8-11) emphasizes the need for a definitive ruling by this Court.

Moreover, the Questions Presented challenge the *ratio decidendi* of the Court of Appeals in its entirety. Petitioners demonstrated below, by detailed analyses of the claims in suit, that none of them, *taken as a whole,* was "identically disclosed or described as set forth in Section 102 of [Title 35]," and the Court of Appeals bottomed its decision on Section 103 alone.

(2) Petitioners do not suggest for a moment that a patent may not be held invalid even though the defendant fails to make proof of the matters stated in Section 103; they recognize that a claim may be unpatentable even if its subject matter as a whole was not obvious to a person of ordinary skill in the art; for example, it might be

fatally lacking in the attainment of any new result; cf. *Armour & Co. v. Wilson & Co.*, (C.A. 7, 1960) 274 F.2d 143, 151 *et seq.* The Court of Appeals, however, found no such infirmities in any of the claims in suit.

The root question here is whether, after Congress defined and delimited the issue of "obviousness" in Section 103, the courts may ignore the mandate of Congress and decide the question of obviousness by other standards. The intent of Congress, by the enactment of Section 103, to outlaw merely personal judgments and fix a *statutory* standard, is as clear and certain as was its intent, by the enactment of Section 271(c), to affirm the doctrine of contributory infringement as it existed before the *Mercoid* case; cf. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 32 LW 4459, 4462, fn. 6; Petition, pp. 7-8. It is equally clear that in enacting Section 282 Congress mandated proof of *every* requirement of Section 103 in order to overcome the presumption of validity attaching to the grant, a presumption which becomes increasingly necessary in the administration of the patent law with the increasing complexities of modern technology; *Williams Mfg. Co. v. United Shoe Machy. Corp.*, (C.A. 6, 1941) 121 F.2d 273, 277; aff'd. 316 U.S. 364 (1942).

(3) If petitioners are right in their contention, they were plainly denied due process in the lower courts because the record is devoid of *any* proof, testimonial or documentary, that the subject matter of any claim in suit was obvious (i) as a whole (ii) in 1943 (iii) to a person having ordinary skill in the electrical circuit art.

The claims are not for the production of "printed circuitry" broadly (cf. Respdt's. Br. pp. 7-8) but for combinations, defined in detail in the claims, the use of which lead to the attainment of new results, or old results in a more facile or economical way. Subject matter of that sort may be patented even though *all* of the steps or elements are severally old. The evidence referred to in respondent's brief does not go to the subject matter of *any* claim as a whole, but only to a step or steps constituting less than the entirety of any claim; steps, moreover, which were known by the Patent Office Examiners to be old when the Eisler applications were before them. Evidence of that sort shows merely (i) that something *less* than the whole subject matter was perceived (ii) at a date after the Eisler inventions were made (iii) by a few persons having far *more* than the ordinary skill of the art. That is not the evidence mandated by Section 103.

The petition should be granted.

Respectfully submitted,

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